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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,742	03/25/2004	Clive Elson	4245/2092	9666
29933	7590	12/11/2007		
PALMER & DODGE, LLP KATHLEEN M. WILLIAMS 111 HUNTINGTON AVENUE BOSTON, MA 02199			EXAMINER WHITE, EVERETT NMN	
			ART UNIT 1623	PAPER NUMBER
			MAIL DATE 12/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/810,742	<b>Applicant(s)</b> ELSON ET AL.	
	<b>Examiner</b> Everett White	<b>Art Unit</b> 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1- 52 is/are pending in the application.
- 4a) Of the above claim(s) 20-50 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 51 is/are allowed.
- 6) ☒ Claim(s) 1-19 and 52 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The amendment filed September 18, 2007 has been received, entered and carefully considered. The amendment affects the instant application accordingly:
  - (A) Claims 1 and 11 have been amended;
  - (B) Claims 51 and 52 have been added;
  - (C) Comments regarding Office Action have been provided drawn to:
    - (I) the specification objection, which has been withdrawn;
    - (II) 112, 1<sup>st</sup> paragraph rejection, rendered moot by new ground of rejection;
    - (III) 102(b) rejection, which has been maintained;
2. Claims 1-52 are pending in the case; Claims 20-50 are withdrawn from consideration as being directed to non-elected inventions.
3. The text of those sections of Title 35, U. S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112, 1<sup>st</sup> Paragraph (New Ground of Rejection)***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's amendment with respect to amended Claim 1 has been fully considered but is deemed to insert new matter into the claims since the specification as originally filed does not provide support for the text "wherein the degree of carboxylation from the carboxymethyl group is lower than the degree of carboxylation from the R group" now recited in instant Claim 1. Applicants point to Examples 1 and 2 in the specification for support of the text in Claim 1. Although Example 2 recites a degree of

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succinylation value and a degree of carboxylation value after two separate procedures, there is no language disclosed in Example 2 or Example 1 which supports the newly added text in instant Claim 1. Claims dependent from Claim 1 are also rejected since the dependent claims do not clarify the newly added text in Claim 1.

Consequently, there is nothing within the instant specification which would lead the artisan in the field to believe that Applicant was in possession of the invention as it is now claimed. See *Vas-Cath Inc. v. Mahurkar*, 19 USPQ 2d 1111, CAFC 1991, see also *In re Winkhaus*, 188 USPQ 129, CCPA 1975.

6. Applicant's arguments with respect to Claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***  
***(New Ground of Rejection)***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-19 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, line 16, the term "the carboxymethyl group" lacks clear antecedent basis since term was not previous recited in Claim 1.

In Claim 1, lines 16 and 17, the phrase "degree of carboxylation from the R group" is not clear since there is no indication in Claim 1 that the representative R groups "alkyl, alkenyl, and aryl" comprise carboxyl groups, which renders Claim 1 indefinite.

Claims dependent from Claim 1 are also rejected since the dependent claims do not clarify the indefinite language in Claim 1.

In Claim 52, line 12, the phrase "one or more heteroatoms" should be changed to - - one or more heteroatoms replacing one or more carbons of the alkyl or alkenyl group

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- - in order to make the claim more definite. See page 4, line 25 of the specification for support.

9. Applicant's arguments with respect to Claims 1-19 and 52 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

10. Claims 1-8 and 11-19 stand rejected under 35 U.S.C. 102(b) as being anticipated by Elson (US Patent No. 5,888,988) for the reasons disclosed on pages 3-5 of the Office Action filed March 19, 2007.

11. Applicant's arguments filed September 18, 2007 and the 1.132 Declaration filed August 13, 2007 by Susan E. Henderson have been fully considered but they are not persuasive. Applicants arguments and the 1.132 Declaration are based on newly amended Claim 1 which require that the recited N-acylated chitinous polymer have a degree of carboxylation from the carboxymethyl group that is lower than the degree of carboxylation from the R group. However, this amendment in Claim 1 was rejected on the ground of reciting "new matter" under the 1<sup>st</sup> paragraph of 35 U.S.C. 112 since the amendment is not supported in the instant specification and rejected as being indefinite under the 2<sup>nd</sup> paragraph of 35 U.S.C. 112 (see rejections above). In view of these rejections, arguments presented by Applicants and the evidence presented in the Declaration that the amendment over come the Elson patent are not persuasive. Accordingly, the rejection of Claims 1-8 and 11-19 under 35 U.S.C. 102(b) as being anticipated by the Elson patent is maintained for the reasons of record.

***Allowable Subject Matter***

12. Claim 51 is allowed.

13. The Elson patent and other prior art of record does not teach or fairly suggest the N-acylated chitinous polymer of instant Claim 1 comprised of subunits of the formula disclosed in Claim 51, wherein the structures representing Y have R groups represented as aryl.

***Reply to Final Must Include Cancellation of Claims Non-Elected with Traverse***

14. This application contains claims 20-50 drawn to an invention nonelected with traverse in the reply filed on June 2, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Summary***

15. Claim 51 is allowed; Claims 1-19 and 52 are rejected; Claims 20-50 are withdrawn from consideration.

***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Examiner's Telephone Number, Fax Number, and Other Information***

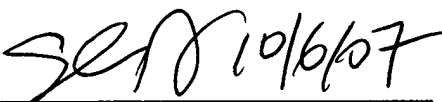
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is 571-272-0660. The examiner can normally be reached on 9:30 to 6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-066127. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
E. White

  
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